

REMARKS CONCERNING THE AMENDMENTS

The amendments to the claims have been made in an effort to more clearly define the present invention and to respond to issues raised in the Office Action. Antecedent basis for the language is found in the concepts described in Example 1, on pages 15-17.

New claims 11-20 recite that the layer consists essentially of the recited ingredients, excluding additive in significant amounts that alter the substantive performance of the layer.

RESPONSE TO THE REJECTIONS

The Rejection Under 35 USC 112, Second Paragraph

This rejection has been addressed and overcome by the Amendment to Claim 10. This rejection is no longer applicable.

The Rejection of Claims 1-10 Under 35 USC 103(a) As Unpatentable Over Lauer, U.S. Patent No. 4,926,190

This rejection asserts that Lauer et al. shows:

- a) an ink jet receiving sheet comprising a support and receiving layer (admittedly shown on column 11, lines 35-44);
- b) the receiving layer comprising
 - i. a high boiling organic solvent (e.g., dibutyl phthalate);
 - ii. a nonionic surfactant; and
 - iii. a hydrophilic binder (e.g., gelatin).
- c) It is asserted that the experimental modification of this prior art [composition] to ascertain optimum operating conditions (e.g., determine compositional proportions) fails to render applicants' claims patentable in the absence of unexpected results.

It must be first appreciated that the Lauer et al. reference does not **specifically** teach the structure and composition of the sheet recited. Instead, Lauer et al. provides a broad and general recipe list from amongst which various ingredients may be selected. As such, the broad and general teaching may be shown to fail in providing an effective teaching of the obviousness of the invention on the basis that the results of a specific combination provide results, in comparison with other combinations taught, that are unique, unexpected, and beneficial. The present specification in fact established that showing.

Example 1 provides a comparison of two types of receivers, both of which are within the broad generic scope of disclosure of Lauer et al. The basis of the rejection is essentially that the selection of materials from among the list of materials identified by Lauer et al. is the selection of equivalent materials, and that there is no invention in combining specific ingredients, **in the absence of unexpected results that establish non-equivalence**. The evidence in this example clearly supports the position in the application that the unique combination of ingredients defined in the claims produces a result that is unique and unexpected with respect to other combinations of materials generally known in the art.

It is also to be noted that the high temperature boiling solvent (e.g., tricresyl phosphate in Example 1) is used solely as a carrier for a UV absorber, and the surfactant is a combination of two anionic surfactants. Nowhere is the specific combination of the binder, high boiling solvent and non-ionic surfactant shown. As the specific combination of ingredients has been shown to provide a unique set of properties, as that unique set of properties is not expected from the teachings of the prior art, and as those properties are improved over combinations of other general ingredients taught to be equivalent, the rejection under 35 USC 103(a) is rebutted. No showing under 35 USC 102(a) has been established as the general listing of a broad range of materials does not constitute a teaching of the specific combination of materials.

Additionally, the surfactants disclosed in Lauer (e.g., column 14, line 26 through column 15, line 15) are again generally added to the materials (column 14, lines 56-60), with only one option being dissolution in the organic solvent phase (where it would be dispersed). Therefore, there is no showing in the examples, or clear requirement in the specification for dispersion of the non-ionic surfactant.

The rejection is in error and should be withdrawn. New claims 11-20 restrict the presence of additional materials, such as the UV absorber, which renders the teachings of Lauer et al. ineffective.

The rejection is in error and must be withdrawn.

If the Examiner believes that issues may be discussed that can advance the prosecution of this application, he is courteously requested to call the below attorney of record at 952.832.9090 to discuss the application.

Respectfully submitted,

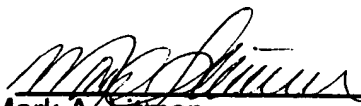
SISMONDI, et al.

By Their Representatives,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being deposited in the United States Postal Service, as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on April 29, 2002.

Mark A. Litman
Name


Signature